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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Anthony J. Baerlocher

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EXAMINER

NGUYEN, BINH AN DUC

ART UNIT

PAPER NUMBER

3713

DATE MAILED: 06/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/933,843

Applicant(s)

BAERLOCHER ET AL.

Examiner

Binh-An D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2006 and December 30, 2003.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-31 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1 and 3-31 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/13/05.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The Amendment filed March 13, 2006 has been received. According to the Amendment, claims 1 and 23-29 have been amended; and claim 2 has been canceled. Currently, claims 1 and 3-31 are pending in the application.

Further, claim 30 has been amended in the Amendment filed December 30, 2003, prior to the last Non-Final Rejection sent July 30, 2003.

Since claims 1, 23, and 29 have been amended to include the restricted Species G (Figure 11, i.e., adding digit) with the elected Species E (Figure 9, i.e., rearranging digits)(see Response to Restriction filed October 30, 2002); and claim 30 has been amended to include Species E, Species G, Species H (Figure 12, i.e., removal of digit), and Species F (Figure 10, i.e., modification or regeneration of at least one of the digits), the restriction of claims 6-22 and 25-28 are hereby withdrawn.

Claims 1 and 3-31 are hereby examined on the merit. Acknowledgment has been made.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 3-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 and 20-50 of copending Application No. 09/934003. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the outstanding application and the copending Application No. 09/934003 claimed a gaming device operated under the control of a controller, said gaming device comprising: a display device; an original award represented by a plurality of individual digits displayed by the display device, said **original award resulting from a gaming event played by a player and wherein the digits indicate an amount of the original award**; and a final award provided to a player, said **final award including a modification of the digits of the original award displayed by the display device, wherein the modified digits of the original award indicate an amount of the final award and wherein the modification method for modification of the original award is selected from a plurality of different award modification methods** (or first, second, and third methods) stored by the controller and including at least: **a rearrangement of at least two of the digits of the original award, an addition of a digit to the digits of the original award, a removal of one of the digits of the original award, and a**

modification of at least one of the digits of the original award (as per claims 1, 9, 16, 23, 29, and 30; and the copending Application No. 09/934003's claims 6-11, 24-27, and 39-41);

wherein the gaming event includes a plurality of player selectable positions displayed by the display device, wherein **the processor enables the player to select the positions, associates digits with the player's selection of the positions and determines the original award based on an order of the digits associated with the positions** (as per claims 6, 23, and 20; and copending Application No. 09/934003's claims 1 and 30);

wherein the gaming event includes a plurality of masked digits displayed by the display device, wherein the processor **enables the player to arrange at least two of the masked digits in an order, and the original award is based on the order of the masked digits arranged by the player** (as per claims 7, 14, and 21; and copending Application No. 09/934003's claims 12, 14, and 21);

and **wherein the gaming event** includes a plurality of selections displayed by the display device, wherein the processor associates digits with said selections, and which **enables a player to associate selections with a one's digit, a ten's digit and a hundred's digit of the original award provided to the player** (as per claims 8, 15, and 22; and copending Application No. 09/934003's claim 16).

Note that, although the limitations of the processor randomly determines to modify said original award (as per claim 5), or when to add a new digit to the original award (as per claim 12), or when to remove the digit from the original award (as per

claim 19) **based on a probability stored in a memory device** accessed by the processor, have not been claimed by the copending Application No. 09/934003, the results of such random determinations in view of the specification of the copending Application No. 09/934003, in fact, are **based on a probability stored in a memory device** (see specification of copending Application No. 09/934003, page 39, 2nd full paragraph; page 41, 3rd full paragraph; and page 43, 1st full paragraph).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments with respect to claims 1, 3-5, 23, 24, and 29-31 filed December 30, 2003, have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh-An D. Nguyen whose telephone number is 571-272-4440. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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